No. 87-1057

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In The Supreme Court of the United States

October Term, 1987

COOPER INDUSTRIES, INC.,

Petitioner,

vs.

JUNO LIGHTING, INC.,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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The Petition for a Writ of Certiorari here is based on supposed conflicts between the Judicial Circuits regarding the evidence to be considered in deciding a motion for judgment notwithstanding the verdict ("JNOV") and upon an alleged violation of the Seventh Amendment right to a jury trial when all relevant evidence is considered in overturning a jury verdict. The trial court granted JNOV holding the patent in suit not infringed and invalid.

Petitioner asserts that the proper rule as to which evidence should be considered in determining whether the verdict was supported by sufficient evidence is that only evidence in support of the verdict be considered, disregarding all other, on a motion for JNOV. Right or wrong,

however, even *under this rule, the granting of JNOV was* proper here.

The subject matter of the patent in suit concerns a lighting fixture having a thermal protective device located on the inside of the fixture sidewall which is to disconnect the fixture when a predetermined temperature is reached outside of the fixture. A thermal protective device or thermal protector is a device which contains a temperature-sensitive bimetallic element, which causes the electrical power to the fixture to cut out or shut off if the temperature on the bimetallic element reaches its rated temperature (0039).[1] In other words, the bimetallic element trips when its rated temperature is reached and opens the electrical circuit to the lamp in the fixture.

The claims of the patent in suit require that the thermal protector senses or responds to temperature outside of the fixture (0041). Thus, the single controlling fact issue as to infringement and validity in this case is whether the thermal protector in Juno's TC2 fixture senses or responds to outside temperature and whether lighting fixtures made in accordance with the claims of the patent in suit can sense or respond to outside temperature.

The District Court found that the Juno TC2 fixture did not and could not infringe any of the claims at issue as the thermal protector therein did not and cannot sense or respond to outside temperature (P.A. A21)[2] and that the claims were invalid under 35 U.S.C. §101 and/or §112 as the device described therein does not and cannot sense or respond to outside temperature as claimed (P.A. A23).

Notably, the Federal Circuit observed in affirming the judgment of Judge Will:

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[1] The page references are to the Joint Appendix filed in the Court of Appeals for the Federal Circuit.

[2] Appendix to the Petition here.

"[W]e conclude, as did the district court, that no substantial evidence supports the jury's finding that Juno's TC2 fixture infringed claims 1-5 and 9-13 of the '512 patent. No witness, either for the plaintiff or the defendant, testified that the thermal protector in Juno's TC2 fixture sensed or responded to the temperature in the area adjacent to the outside of the container. The only evidence of infringement Cooper offered at trial was the testimony of the inventor, Paul Kristofek. He stated that he *assumed* that the Juno TC2 fixture responded to the outside temperature.

Juno, on the other hand, presented both testimony and test data which showed that the thermal protector in its fixture responded to the temperature *inside* the container. In fact, the evidence showed conclusively that the thermal protector could not sense or respond to the outside temperature if mounted inside.

Thus, we agree with the district court that, on this record, reasonable persons understanding the evidence could not have reached a verdict of infringement.

* * *

Despite the inventor's theory of how his invention worked, the only evidence showed that a thermal protector mounted inside a container as specified in the '512 patent would not and could not sense or respond to the outside temperature. Therefore, the claims are invalid for either lack of utility under §101 or lack of enablement under §112, first paragraph." (P.A. A26-27).

Thus, as the courts below recognized, no evidence was presented by Petitioner at trial that the thermal protector in the Juno TC2 fixture senses or responds to outside temperature or that such sensing or response was even possible in any fixture supposedly made in accordance with the claims of the patent in suit. Therefore, under any of the allegedly conflicting rules for determining a Rule 50(b) JNOV motion, JNOV was proper in this case, and the rule espoused by Petitioner cannot help Petitioner here.

Accordingly, Respondent Juno Lighting, Inc.[3] opposes the Petition for Writ of Certiorari requested in this case.

STATEMENT OF THE CASE

A. Petitioner Did Not Offer Any Evidence At Trial Of The Thermal Protector In Respondent's Fixture Or Any Fixture Made In Accordance With The Claims Sensing Or Responding To Outside Temperature So As To Support The Verdict As To Infringement Or Validity

The factual record in this case amply demonstrates that the granting of JNOV on both the issues of validity and infringement was proper under any and all of the supposedly conflicting rules for considering evidence on a JNOV motion as applied by the Judicial Circuits.

The claims of the patent in suit require that a thermal protector discontinue operation of a lighting fixture in response to the temperature in an area surrounding the outside of the lighting fixture reaching a predetermined temperature (0903-0904).

At trial, the only evidence that Petitioner offered regarding infringement by Respondent was the testimony of the inventor, Mr. Kristofek. He testified that he assumed that the Juno TC2 device responded to the temperature in an area surrounding the outside of the lighting fixture reaching a predetermined temperature (0169). Although Petitioner now claims that Mr. Kristofek testified that the TC2 fixture infringed, this is not supported by the record. Neither the District Court nor the Federal Circuit deemed the testimony relied upon by Petitioner to constitute any evidence of infringement. In fact, no test results or other evidence was offered by Petitioner to show that the thermal protector in the Juno TC2 fixture responds to temperature outside of the fixture as required

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[3] Pursuant to Rule 28.1, Juno Lighting, Inc. states that it does not have any subsidiaries or affiliates.

by the claims. Indeed, Mr. Kristofek admitted that a fixture having a thermal protector that sensed or responded to inside temperature was not covered by nor would infringe the claims of the patent in suit (0230).

The evidence presented by Respondent at trial established that the thermal protector in the Juno (Respondent's) TC2 fixture responded only to inside temperature and, by Mr. Kristofek's own assessment, did not infringe. The evidence also clearly and convincingly established that the outside temperature could not be sensed by either Respondent's TC2 fixture or Petitioner's Halo H7T fixture.

In that regard, Mr. Stauner, a Juno engineer, testified regarding the results of tests he ran on the Juno TC2 and Halo H7T fixtures (1090-1094). The test results showed that, during operation of the fixtures, the temperatures outside of the fixture were always lower than the temperature inside of the fixture and, thus, temperatures outside the fixture never reached the rated cut-out temperature of the thermal protector in either fixture. Based upon these tests, Mr. Stauner testified that the thermal protector in the Juno TC2 fixture responded to temperature inside the fixture and not to temperature immediately outside the fixture side wall (0325-0328, 0333).

Mr. Fremont, President of Respondent, testified that the thermal protector in the Juno TC2 fixture cuts off the lamp in response to the temperature inside of the fixture (0510-0511), and does not respond to temperature outside the fixture (0513).

Professor Liljequist, Respondent's technical expert, testified regarding the results of tests he conducted with the Juno TC2 and Halo H7T fixtures by taking temperature readings at various locations inside and outside of the fixtures covered with insulation. The temperature readings were taken up to and including the time that the thermal protector tripped and turned off the lamps (0648, 0652-0657, 0672-0681).

Based on the results of these tests, (1150-1158, 1206-1207), Prof. Liljequist testified that in neither the Juno TC2 fixture nor the Halo H7T fixture does the thermal protector sense or respond to temperature outside the fixture housing (0651-0652).

Prof. Liljequist also testified that heat can only move in one direction, i.e., from hot to cold, and his observations established that, because this basic scientific principle governed the operation of the two fixtures, the cooler outside temperature could not get inside to the thermal protector to trip it. Prof. Liljequist's test results confirmed that cool air cannot flow to hotter areas, and that it would be impossible for the Juno TC2 or Halo H7T to sense or respond to temperature outside the fixture that is always cooler than the inside temperature (0682-0683, 0695-0699, 0705).

Therefore, Prof. Liljequist concluded not only that the Respondent's TC2 and Petitioner's H7T fixtures respond to inside temperatures, but that they cannot respond to outside temperature and, thus, the TC2 fixture could not infringe the claims at issue nor could any fixture supposedly made in accordance with the claims function as claimed (0682-0683, 0695-0705).

Prof. Liljequist's testimony was completely uncontroverted. Petitioner offered no evidence whatsoever to rebut this testimony. Even Mr. Kristofek was forced to admit that the thermal protector in the Halo (Petitioner's) H7T fixture responded, at least in part, to inside temperature, not just to outside temperature, as required by the claims (0213, 0255, 0427). Thus, it is clear that Petitioner presented no evidence at all of the single controlling fact issue in the case and, therefore, presented no evidence to support the jury verdict.

Petitioner argues that the listing by Underwriters Laboratories ("UL") of the Juno TC2 fixture constitutes sufficient evidence of infringement. At most, the listing comprises a circumstance of minimal probative value and

relevance; however, Petitioner's argument is misguided and an attempt to create evidence where none exists.

First of all, Petitioner has mischaracterized the UL test. The UL test does not require disengagement of the lamp in response to a predetermined outside temperature of 90°C. Indeed, the test simply does not require that the protector respond to or sense outside temperature at all.

Petitioner's argument is belied by its own documents introduced into evidence at trial. In a Cooper (Halo) brochure (1047-1052), the UL test requirements are described and it is stated that Halo (Cooper) has a fixture, the H7T, which satisfies the UL requirements (1049). The H7T fixture is then described as having a thermal protector that stops current to the lamp "when the temperature *in* the housing reaches a certain point" (emphasis added) (1051). Thus, the fact that the Juno TC2 fixture was listed by UL has nothing to do with the fixture responding to outside temperature as required by the claims of the patent in suit.

That Juno's TC2 fixture passed the UL test is not evidence of infringement nor does that fact weigh against the invalidity of the claims of the patent in suit. That is further demonstrated by the fact that a LITE BOX fixture of Prescolite, a third party, was the first lighting fixture to pass the UL test in question and be listed by UL (0445A). The Prescolite fixture is prior art to the alleged invention of the patent in suit (0053A) and is embodied in Druffel, U.S. Patent No. 4,358,635 (1019-1024). All of the originally filed claims in the application for the patent in suit were rejected over Druffel (0992). In response to the rejection, Petitioner admittedly narrowed the claims to recite that the thermal protector of the claimed fixture responds to temperature outside of the fixture (0041) in order to distinguish over Druffel (0996-0997), which was argued to have a thermal protector that sensed an inside temperature.

Thus, Petitioner did not consider the Prescolite fixture

to be an infringment of the claims of the patent in suit, as whatever infringes if later, anticipates if earlier. *Peters v. Active Manufacturing Co.*, 129 U.S. 530, 537 (1889). As the Prescolite fixture passed the UL test, by Petitioner's own admission, passing the UL test is obviously no evidence at all of infringement or the validity of the claims here at issue.

Clearly, whether evidence presented by Petitioner at trial is "sufficient" or not is actually a moot point as the alleged evidence presented by Petitioner was in fact, no evidence of infringement or validity as was recognized by both the District Court and the Court of Appeals. Indeed, under each of the supposedly conflicting approaches argued by Petitioner for deciding whether a jury verdict is supported by sufficient evidence, the District Court's granting of JNOV was mandated.

Simply put, Petitioner offered no evidence to prove that the thermal protector in the accused Juno TC2 fixture responded to temperature outside of the fixture, as required by the patent claims in order to find infringement. Moreover, Petitioner offered no evidence to prove that fixtures supposedly constructed in accordance with the patent in suit could operate by having the thermal protector respond to temperature outside of the fixture, as was necessary to rebut Respondent's contrary evidence, and to sustain validity of the patent claims at issue.

B. The District Court's Opinion Granting Judgment Notwithstanding The Verdict

1. Infringement

In its opinion granting JNOV, the District Court painstakingly went through the evidence (P.A. A14-23), not ignoring evidence presented by Petitioner or focusing on Respondent's contrary evidence, as Petitioner would have this Court believe, but searching for any evidence to support the jury's verdict.

With respect to the issue of infringement, the District Court found that Petitioner presented no evidence that Respondent's TC2 fixture sensed or responded to outside temperature as required by the claims at issue (P.A. A21):

> "No witness testified that the thermal protection device in the defendant's challenged TC2 unit responded to or sensed the temperature in an area adjacent to the exterior surface of the housing as claimed in Claims 1 and 9 of the patent in suit. Given the history of the patent application and the insertion, in order to obtain a patent, of the specific reference to the area adjacent "to the outside" of the container, this is a classic example of the doctrine of file wrapper estoppel. The claims of the patent as issued are limited to a device in which the thermal protector senses or responds to the temperature in the area adjacent to the outside of the container. The evidence leads to only one possible conclusion. The plaintiff failed to establish by a preponderance of the evidence that the challenged device falls within or infringes the claims of the '512 patent."

2. Validity

With respect to the issue of validity, the District Court also found that Petitioner presented no evidence that a fixture supposedly made in accordance with the claims could sense or respond to outside temperature (P.A. A22-23):

> "Stauner and Liljequist also testified that it is a basic law of physics that heat travels to cold and cold does not travel to heat, that given the heat source inside the container and the thermal sensor mounted inside the container, there is no way that the temperature outside the container can influence or trigger its operation. Finally, plaintiff's vice-president in charge of sales, *Schnoll*, testified that the sensor responds to the temperature inside the container.
>
> Plaintiff offered no evidence to rebut this testimony. Even the inventor, Kristofek, acknowl-

> edged that the inside mounted sensor had to be influenced at least in part by the temperature inside the container *though* he believed that it responded primarily to the outside temperature. He had, however, made no tests to confirm his belief. Nor did plaintiff present any other witness who had conducted any tests or had any basis for concluding that the device described in the '512 patent responded in any way to the temperature outside the container or could possibly do so.
>
> Given the evidence presented by the defendant and the absence of any rebuttal evidence, the defendant clearly and convincingly established that the device described in the '512 patent does not and cannot function as claimed. Accordingly, the patent is invalid."

The District Court further stated (P.A. A23):

> "As indicated, I am convinced that upon the record before the jury, reasonable persons understanding the evidence could not have reached the three liability verdicts returned in this case. Accordingly, I am bound to set them aside. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1546 (Fed. Cir. 1983); *Quaker City Gear Works, Inc. v. Skil*, 747 F.2d 1446 (Fed. Cir. 1984), *cert. denied*, 105 S. Ct. 2676 (1985)."

Thus, it is clear that the District Court expressly granted JNOV on the issues of validity and infringement on the basis of no evidence that the thermal protector in Respondent's TC2 fixture senses or responds to outside temperature or that a fixture supposedly made in accordance with the claims at issue could function as claimed.

C. Affirmance By The Court Of Appeals For The Federal Circuit

In affirming the District Court's granting of JNOV, the Court of Appeals for the Federal Circuit ("Federal Circuit") noted that Petitioner had to show that there was substantial evidence to support the jury's finding. The Court also noted that "substantial evidence" is such relevant evidence

from the record taken as a whole as might be accepted by a reasonable mind as adequate to support the finding under review (P.A. A26).

As to both of the issues of validity and infringement, as quoted above, the Federal Circuit agreed with the District Court that Petitioner presented no evidence of the single controlling fact issue so as to support the jury verdict (P.A. A26-27).

Indeed, the Federal Circuit thought that the case was so clearly properly decided by the District Court that it deemed its affirming opinion to not warrant publication as the opinion "does not add significantly to the body of law and is not of widespread legal interest." (P.A. A25).

Accordingly, the Federal Circuit denied Petitioner's Motion for Publication of Decision (P.A. A29). Without question, such a clearly correct decision as the granting of JNOV here is not the stuff of which a granting of a Petition for Certiorari is made.

REASONS FOR DENYING THE PETITION

A. The Courts Below Applied The Correct Standard of Review

This Court has noted " . . . the standard for a directed verdict under Federal Rule of Civil Procedure 50(a), which is that the trial judge must direct a verdict if, under the governing law, there can be but one reasonable conclusion as to the verdict. *Brady v. Southern R. Co.*, 320 US 476, 479-480, (1943)."[4] *Anderson v. Liberty Lobby, Inc.* 477 U.S. 242, 91 L.Ed2d 202, 213 (1986). "[R]ecent decisions of high authority have established a more reasonable rule, that in every case, before the evidence is left to the jury, there is a preliminary question for the judge, not whether there

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[4] The Petitioner (n.4 at p. 6) correctly notes that the standard for a motion for JNOV is the same as for a directed verdict. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986).

is literally no evidence, but whether there is any upon which a jury could properly proceed to find a verdict for the party producing it, upon whom the onus of proof is imposed . . . See also *Pleasants v. Fant*, 22 Wall 116, 120-121 (1875); *Coughran v. Bigelow*, 164 U.S. 301, 307 (1896); *Pennsylvania R. Co. v. Chamberlain*, 288 U.S. 333, 343 (1933)." *Anderson, supra*, 477 U.S. at ___, 91 L.Ed2d at 213.

This was precisely the approach and standard both the District Court and Court of Appeals said was appropriate and which they followed. Each court looked for substantial evidence upon which a jury could reasonably find infringement and/or validity, and did not find it.

The case was properly decided and the Petition should be denied.

B. Petitioner Overstates The Conflict Between The Circuits

Petitioner makes much of supposed conflicts between the Circuits as to what evidence is considered in deciding whether a jury verdict is supported by sufficient or substantial evidence. However, Petitioner clearly overstates the extent of the conflicts, especially with respect to the Federal Circuit which heard the appeal in this case.

With respect to the Federal Circuit, Petitioner argued in its Petition for Rehearing and Suggestion for Rehearing In Banc, and continues to argue here, the baseless position that a conflict exists between various Federal Circuit decisions on JNOV Motions. Specifically, Petitioner relies upon a supposed conflict between the Federal Circuit's affirmance here and its decision in *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986). However, the JNOV decisions of the Federal Circuit are totally consistent and no such conflict exists as the Federal Circuit itself recognized in denying and declining Petitioner's Petition for Rehearing and Suggestion for Rehearing In Banc, respectively.

Beginning with the seminal decision in *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983), the Federal Circuit has, without deviation, applied the same standard in considering appeals from decisions regarding motions for directed verdict or JNOV. Please see *Vieau v. Japax, Inc.*, 823 F.2d 1510, 1515 (Fed. Cir. 1987); *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627 (Fed. Cir. 1987); *Verdegaal Brothers, Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Petitioner's reading of *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986) is distorted and erroneous and its reliance thereon misplaced. In that case, the Federal Circuit examined the evidence in the record and specifically found that there was indeed substantial evidence to support the jury's verdict. That finding was made after a careful analysis of all of the relevant evidence. Significantly, the Court stated "[t]his is not a case in which there was no evidence in support of a jury's finding, or one in which the only evidence relating to a finding was contrary to that finding." 806 F.2d at 1573. Of course, the situation in *Orthokinetics* is exactly the opposite of the situation here.

Petitioner further contends that the Federal Circuit's decision in *Quaker City Gear Works, Inc. v. Skil Corp.*, 747 F.2d 1446 (Fed. Cir. 1984) and *Jamesbury Corp. v. Litton Indus. Products, Inc.*, 756 F.2d 1556 (Fed. Cir. 1985) are at odds with *Orthokinetics*. It is not seen how any reasonable mind reading those decisions can come to that conclusion.

More importantly, the purported conflict between the various Circuits is totally irrelevant to this case. For example, Petitioner seems to rely heavily on the Eighth Circuit in *Dace v. ACF Industries, Inc.*, 722 F.2d 374, 376 (8th Cir. 1984) with the following quote therefrom:

> "... [W]e have said that the court is not to consider questions of credibility when deciding whether to grant a directed verdict.... That

> statement necessarily implies that evidence favorable to the moving party may not be considered, because if it were the court would have to pass on the credibility of that party's witnesses."

No one would deny that questions of credibility are absolutely within the exclusive province of the jury. But that is exactly not the case here, nor can Petitioner contend that it is. Here, Petitioner introduced no evidence which supported the jury verdict of validity and infringement and there are no questions of witness credibility.

C. The Granting Of JNOV Here Did Not Violate The Seventh Amendment

Petitioner argues that the granting of JNOV after a consideration of "all of the evidence" violates the Seventh Amendment right to trial by jury. However, it is abundantly evident that Petitioner's right to a jury trial was not violated here.

This Court has made it patently clear that the guarantee of a jury trial given by the Seventh Amendment does not deprive the Federal Courts of the power in a jury case to direct a verdict (or grant JNOV) upon the ground of the insufficiency of the evidence. *Galloway v. United States*, 319 U.S. 372, 389 (1942). In this case, Petitioner's evidence was, without question, insufficient to support the jury verdict.

If Petitioner's argument that a consideration of "all of the evidence" violates the right to a jury trial were carried to its logical conclusion, there could never be a JNOV (or a directed verdict) because the existence of any pretense or scintilla of evidence by the non-movant would be sufficient. Such an absurd concluson defies all logic and is contrary to all accepted judicial procedure. In a decision cited by Petitioner, this Court considered the standards applicable to a motion for summary judgment (and, by extension, to directed verdict and JNOV). In *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 91 L.Ed2d 202, 214, 216 (1986), the Court states:

> "In essence, though, the inquiry under each is the same: whether the evidence presents a sufficient disagreement to require submission to a jury *or whether it is so one-sided that one party must prevail as a matter of law.*
>
> * * *
>
> In sum, we conclude that the determination of whether a given factual dispute requires submission to a jury must be guided by the substantive evidentiary standards that apply to the case." (emphasis added)

To prevail on the issue of infringement, Petitioner was required to convince reasonable persons that infringement existed by a preponderance of the evidence. Implicit in such a standard is, of course, an examination and balancing of all of the evidence in the relevant record. The record is clear that Petitioner fell far short of discharging its burden of proof on that issue. Furthermore, Petitioner failed to rebut any of the clear and convincing evidence presented by Respondent at trial regarding the invalidity of the patent in suit. Petitioner's suggestion that the court must consider only the alleged evidence that supports the verdict is fallacious. It would appear that Petitioner is attempting to achieve what the Federal Circuit recently criticized when it stated "[a]n appeal is not a means for counsel to cure mistakes and omissions made at trial." *DMI, Inc. v. Deere & Co.*, 802 F.2d 421, 426 (Fed. Cir. 1986).

D. Under Any Standard Of Review JNOV Was Proper Here

This case is clearly not the proper case to resolve differences or conflicts, if any, in the standards of review on JNOV motions. Whether only Petitioner's alleged evidence, or all the evidence, is considered and evaluated, both the District Court and the Federal Circuit held there was no evidence in the record to support the jury verdict of either infringement or validity. Thus, Petitioner cannot prevail under any appropriate standard.

With respect to the issues of validity and infringement, Petitioner argues (p. 5) that the courts below ignored evidence supporting the verdict, focused on Respondent's contrary evidence, and concluded that there was no evidence in support of the verdict. Nothing could be further from the truth. The District Court carefully analyzed the relevant evidence relating to infringement (P.A. A16-21) and to validity (P.A. A21-23).

After analyzing all of the inventor's testimony relied upon by Petitioner, the District Court said (P.A. A17):

> "Finally, he agreed that a light fixture in which the thermal protector responded to temperature inside the fixture would not infringe his patent. (Tr., p. 136)."

Thus, in addition to all of the relevant evidence introduced by Respondent, the inventor himself finally admitted that there was no infringement. Clearly, the alleged evidence presented by Petitioner did not constitute any evidence of infringement or validity and the evidence presented by Respondent demonstrated that there could not possibly be any infringement and that the claims of the patent in suit called for an impossible result and were, therefore, invalid.

On appeal, the Federal Circuit again reviewed the record and affirmed the judgment of the District Court in all respects.

E. Adopting Petitioner's Position Here Would Sanction An Absurd Result

The absurdity of Petitioner's asserted position is best illustrated by considering the JNOV of invalidity. It is basic hornbook patent law that a U.S. Patent is presumed valid (35 U.S.C. §282). Theoretically, a plaintiff-patentee need only introduce his patent in evidence and the defendant then has the burden to prove invalidity by clear and convincing evidence overcoming the presumption. According to Petitioner's thesis, a JNOV could never be warranted or sustained because the court must focus

only on Petitioner's favorable evidence, namely, the bare patent itself. That is exactly what Petitioner is contending here because Petitioner introduced no evidence other than the patent to support a verdict of validity in the face of the clear and convincing proof of invalidity offered by Respondent.[5]

Reviewing the record with respect to validity, the District Court noted that at least three witnesses testified emphatically, and with supporting test data, that Petitioner's fixture (as well as Respondent's) could not function as claimed. The witnesses also testified about the basic laws of physics that applied. Because of this clear, convincing, and absolute evidence of invalidity, the District Court pointed out that "Plaintiff offered no evidence to rebut this testimony." (P.A. A22).

After reviewing the record on appeal, the Federal Circuit said:

> Despite the inventor's theory of how his invention worked, *the only evidence* showed that a thermal protector mounted inside a container as specified in the '512 patent would not and could not sense or respond to the outside temperature. Therefore, the claims are invalid for either lack of utility under §101 or lack of enablement under §112, first paragraph (emphasis added). (P.A. A27).

Quoting from *Orthokinetics*, 806 F.2d at 1570, the District Court pointed out (P.A. A22) that "[w]hen, as here, evidence is introduced challenging the validity of a patent, 'a patentee would be well advised to introduce evidence sufficient to rebut that of the challenger.'"

Once again, it is abundantly clear that Petitioner introduced absolutely no evidence, let alone substantial

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[5] Interestingly, the Petition for Writ of Certiorari in *Fonar Corp. v. Johnson & Johnson*, No. 87-822, relied upon by Petitioner here only involves the issue of infringement, not validity.

or sufficient evidence, to rebut the clear and convincing proof of invalidity. It should also be noted that the question of enablement under 35 U.S.C. §112 is a question of law which may have underlying questions of law or fact. *Quaker City Gear Works, Inc. v. Skil Corp.*, 747 F.2d 1446, 1453 (Fed. Cir. 1984). Because Petitioner did not introduce any evidence to rebut the clear and convincing proof presented by Respondent, the District Court and the Federal Circuit properly held the patent invalid as a matter of law.

Petitioner places great emphasis upon *Wilkerson v. McCarthy*, 336 U.S. 53 (1949) which supports review of only evidence favoring the non-moving party on a motion for a directed verdict or JNOV. However, this is exactly what both courts below did in deciding this case. Whether *Wilkerson v. McCarthy* states a *sui generis* rule for federal employees' liability cases is a matter of some controversy. 9 C. Wright & A. Miller, Federal Practice and Procedure §2529 (1971) and please see *Boeing Co. v. Shipman*, 411 F.2d 365 (5th Cir. 1969). This is certainly not a FELA case. However, even in FELA cases, a directed verdict or JNOV, whatever standard of review of the evidence is used, is appropriate where there is "no evidence" supporting the non-moving party. *Moore v. Chesapeake & Ohio Railway Co.*, 340 U.S. 573, 578 (1950).

Without question, there is no standard of review which would help Petitioner here. Petitioner presented no evidence that Respondent's TC2 fixture senses or responds to outside temperature or that a fixture made in accordance with the claims at issue could sense or respond to outside temperature as required by the claims. Thus, Petitioner presented no evidence to support the jury verdict. Indeed, although Petitioner complains of the review of "all of the evidence" undertaken by both courts below, it was aided, not penalized, by the review of the entire record to search for sufficient evidence to support the jury verdict. However, even a search of the entire record could not

uncover any evidence, sufficient or otherwise, to support the verdict.

Accordingly, JNOV was appropriate in this case under any standard of review and, therefore, this is not the proper case to resolve the conflicts, if such exist, postulated by Petitioner.

CONCLUSION

For the reasons stated above, Respondent urges that the Petition for Writ of Certiorari be denied.

Respectfully submitted,

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